UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/589,923	08/17/2006	Stefan Amon	AT04 00008US1	3761

65913 7590 02/17/2010

NXP, B.V.
NXP INTELLECTUAL PROPERTY & LICENSING
M/S41-SJ
1109 MCKAY DRIVE
SAN JOSE, CA 95131

EXAMINER	
HORNING, JOEL G	

ART UNIT	PAPER NUMBER
1792	

NOTIFICATION DATE	DELIVERY MODE
02/17/2010	ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

ip.department.us@nxp.com

Advisory Action Before the Filing of an Appeal Brief	**Application No.** 10/589,923	**Applicant(s)** AMON ET AL.	
	Examiner JOEL G. HORNING	**Art Unit** 1792	

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 29 January 2010 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE.

1. ☒ The reply was filed after a final rejection, but prior to or on the same day as filing a Notice of Appeal. To avoid abandonment of this application, applicant must timely file one of the following replies: (1) an amendment, affidavit, or other evidence, which places the application in condition for allowance; (2) a Notice of Appeal (with appeal fee) in compliance with 37 CFR 41.31; or (3) a Request for Continued Examination (RCE) in compliance with 37 CFR 1.114. The reply must be filed within one of the following time periods:
   a) ☐ The period for reply expires _____months from the mailing date of the final rejection.
   b) ☒ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.

   Examiner Note: If box 1 is checked, check either box (a) or (b). ONLY CHECK BOX (b) WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

NOTICE OF APPEAL

2. ☐ The Notice of Appeal was filed on _____. A brief in compliance with 37 CFR 41.37 must be filed within two months of the date of filing the Notice of Appeal (37 CFR 41.37(a)), or any extension thereof (37 CFR 41.37(e)), to avoid dismissal of the appeal. Since a Notice of Appeal has been filed, any reply must be filed within the time period set forth in 37 CFR 41.37(a).

AMENDMENTS

3. ☐ The proposed amendment(s) filed after a final rejection, but prior to the date of filing a brief, will not be entered because
   (a) ☐ They raise new issues that would require further consideration and/or search (see NOTE below);
   (b) ☐ They raise the issue of new matter (see NOTE below);
   (c) ☐ They are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
   (d) ☐ They present additional claims without canceling a corresponding number of finally rejected claims.

   NOTE: _____. (See 37 CFR 1.116 and 41.33(a)).
4. ☐ The amendments are not in compliance with 37 CFR 1.121. See attached Notice of Non-Compliant Amendment (PTOL-324).
5. ☐ Applicant's reply has overcome the following rejection(s): _____.
6. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
7. ☐ For purposes of appeal, the proposed amendment(s): a) ☐ will not be entered, or b) ☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.
   The status of the claim(s) is (or will be) as follows:
   Claim(s) allowed: _____.
   Claim(s) objected to: _____.
   Claim(s) rejected: _____.
   Claim(s) withdrawn from consideration: _____.

AFFIDAVIT OR OTHER EVIDENCE

8. ☐ The affidavit or other evidence filed after a final action, but before or on the date of filing a Notice of Appeal will not be entered because applicant failed to provide a showing of good and sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented. See 37 CFR 1.116(e).
9. ☐ The affidavit or other evidence filed after the date of filing a Notice of Appeal, but prior to the date of filing a brief, will not be entered because the affidavit or other evidence failed to overcome all rejections under appeal and/or appellant fails to provide a showing a good and sufficient reasons why it is necessary and was not earlier presented. See 37 CFR 41.33(d)(1).
10. ☐ The affidavit or other evidence is entered. An explanation of the status of the claims after entry is below or attached.

REQUEST FOR RECONSIDERATION/OTHER

11. ☒ The request for reconsideration has been considered but does NOT place the application in condition for allowance because: See Continuation Sheet.
12. ☐ Note the attached Information *Disclosure Statement*(s). (PTO/SB/08) Paper No(s). _____
13. ☐ Other: _____.

/Michael Cleveland/
Supervisory Patent Examiner, Art Unit 1792

/J. G. H./
Examiner, Art Unit 1792

Continuation of 11. does NOT place the application in condition for allowance because: Applicant's arguments filed 01-29-2010 have been fully considered but they are not persuasive.

1. Applicant first argues that Brennan teaches reinforcing some areas of the diaphragm, while leaving other areas exposed, so that when modifying Nonaka in view of Brennan, one would necessarily leave some areas of the diaphragm exposed. Applicant further argues that this means that these uncoated areas would not have improved abrasion resistance, weather resistance and surface hardness, so it is not reasonable to combine the references.

As a threshold matter, even if one were to not coat the entire diaphragm surface of Nonaka with the polymer, the applied coating would improve the weatherability, scratch resistance and surface hardness of the diaphragm wherever it was added to the surface. In order to improve these properties of the diaphragm surface, it is reasonable to combine the references, producing improved material properties in the surface and improved acoustic properties to the device. Additionally, Nonaka does not appear to require that the entire surface of the diaphragm be coated in order to produce their described benefits, so there is no conflict in only coating part of the diaphragm surface. Furthermore, the test for obviousness is not whether the features of a secondary reference may be bodily incorporated into the structure of the primary reference; nor is it that the claimed invention must be expressly suggested in any one or all of the references. Rather, the test is what the combined teachings of the references would have suggested to those of ordinary skill in the art. See In re Keller, 642 F.2d 413, 208 USPQ 871 (CCPA 1981). In this case, Brennan is the secondary reference and teaches including creased areas and varying the degree of polymer reinforcement in different areas of the diaphragm (specifically between the central and creased areas) in order to produce the desired acoustic properties in that diaphragm. That the Brennan example does not happen to coat the entire surface of the diaphragm, while, as indicated by applicant, a person following Nonaka might find it more desirable to coat the entire surface of the diaphragm is not part of the test for obviousness. What the references would suggest to a person of ordinary skill in the art at the time of invention would be to include creased areas and vary the degree of reinforcement in the Nonaka diaphragm in order to produce the optimal acoustic properties for the speaker diaphragm. If, as applicant believes, according to the teaching of Nonaka, the Nonaka diaphragm must have a continuous coating, then Nonaka in view of Brennan would have such a continuous coating, it would just also have varying degrees of reinforcement and creased areas in order to produce improved acoustic properties. The argument is not convincing.

2. Applicant then argues that the stated combination of references would render the prior art reference unsuitable for its intended purpose.

Both Nonaka and Brennan are directed towards producing acoustic diaphragms for speakers. Applicant has presented no argument that reasonably suggests that, as applied, Nonaka in view of Brennan would produce a product unsuitable as a speaker diaphragm. Furthermore, applicant has presented no argument that reasonably suggests that Nonaka in view of Brennan would not have improved abrasion resistance, weatherability and surface hardness compared to an uncoated diaphragm. The argument is not convincing.

3. In response to applicant's argument that the '038 reference is nonanalogous art, it has been held that a prior art reference must either be in the field of applicant's endeavor or, if not, then be reasonably pertinent to the particular problem with which the applicant was concerned, in order to be relied upon as a basis for rejection of the claimed invention. See In re Oetiker, 977 F.2d 1443, 24 USPQ2d 1443 (Fed. Cir. 1992). In this case, '038 is directed towards a process for spraying liquid polymeric materials onto what will eventually become a speaker diaphragm, so it is in the field of methods for producing speaker diaphragms. It is also highly relevant to applicant's specific problem of how to spray liquid polymers onto materials which will eventually become speaker diaphragms. The argument is not convincing.